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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,993	12/31/2001	Ernest A. Hopcus	56336US002	5306

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Office of Intellectual Property Counsel
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EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/24/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/036,993

Applicant(s)

HOPCUS ET AL.

Examiner

Jane J Rhee

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-11,14 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsukazaki et al.

Tsukazaki et al. discloses a removable core for supporting a pre-stretched elastomeric tube in a radially expanded condition comprising a tube (col. 1 lines 6-9) having a first end and a second end, at least one primary line of localized weakening starting at the first end and terminating at the second end of the tube (figure 8 number 33), and a plurality of substantially parallel secondary lines of localized weakening (figure 8 number 36), wherein each secondary weakening line extends from the at least one primary weakening line at the one side thereof (figure 8 number r1) to a termination point at the other side of at least one primary weakening lines alternately extend from at least one primary weakening line to termination points on opposite sides of at least one primary weakening line to define at least one strip beginning at the first end of the tube and continuing substantially in a serpentine manner to the second end of the tube (figure 8 number 36 and 31). Tsukazaki et al. discloses that at least one strip comprises a free end starting from the second end of the tube and extending through the tube so as to project from the first end of the tube (figure 8 number 37). Tsukazaki et al.

Art Unit: 1772

discloses that each secondary weakening line extends substantially circumferentially about the tube (figure 8 number 36). Tsukazaki et al. discloses that at least one primary weakening line extends alternately to opposite lateral sides of a straight phantom line (figure 8 number 33). Tsukazaki et al. discloses that at least one primary weakening line extends symmetrically to the phantom line (figure 8 number 33). Tsukazaki et al. discloses that at least one primary weakening line has a zig-zag wave form (figure 6). Tsukazaki et al. discloses that for wherein all secondary weakening lines the distance in circumferential direction by which a termination point of a secondary weakening line is spaced from at least one primary weakening line is constant (figure 8 number 36). Tsukazaki et al. discloses that for wherein all of the secondary weakening lines the distance in circumferential direction by which a termination point of a secondary weakening line is spaced from at least one primary weakening line is smaller than a width defined by two successive outermost locations of the at least one primary weakening line arranged on opposite lateral sides of the phantom line (figure 8 numbers 36 and q2). Tsukazaki et al. discloses that the distance is substantially the width of the strip within its portions close to the termination points (figure 8 number 37). Tsukazaki et al. discloses that wherein the tube at the termination points of the secondary weakening lines is provided with radially extending holes (figure 8 numbers p). Tsukazaki et al. discloses that the overall extension of at least one primary weakening line is inclined with respect to a longitudinal dimension of the tube (figure 8 number 33). Tsukazaki et al. discloses that the secondary weakening lines are comprised of perforations in the tube (col. 3 lines 45). Tsukazaki et al. discloses that the secondary

Art Unit: 1772

weakening lines has a reduced thickness in relation to the remaining parts of the tube (col. 3 lines 45).

Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation of an extruded tube wherein the primary and secondary weakening lines are formed using means to remove material from the extruded tube by including methods of ablation selected from the group consisting of laser ablation, electron beam ablation, plasma ablation, and fluid jet ablation and methods for mechanically cutting the

Art Unit: 1772

extruded tube is a method of production and therefore does not determine the patentability of the product itself.

3. Claims 29-43,46 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsukazaki et al.

Tsukazaki et al. discloses a removable core for supporting a pre stretched elastomeric tube in a radially expanded condition (col. 1 lines 6-9) comprising a unitary tube having first and second opposite ends, a plurality of sections of a primary line (figure 8 numbers Q1,Q2, Q3) of localized weakening space apart and arranged adjacent to each other where in the arrangement of the plurality of primary weakening line section extends from the first end of the tube to the second end thereof (figure 8 numbers Q1, Q2, Q3) and a plurality of substantially parallel secondary lines of localized weakening (figure 8 number 36), a group of the secondary weakening lines being associated to each of the primary weakening lines sections (figure 8 number 36), respectively, wherein each secondary weakening line of the group extends from the associated primary weakening line section at the one side thereof to a termination point at the other side of the respective primary weakening line section (figure 8 number 36, R1 and p1) and spaced apart there from, wherein adjacent secondary weakening lines of the group extend form the respective primary weakening line section at different sides thereof to termination points (figure 8 number r1) at the respective other side of the respective primary weakening line section, and wherein from one end of a respective primary weakening line section there extends a secondary weakening line at the one side of this primary weakening line section to an opposite end of an adjacent primary

Art Unit: 1772

weakening line section at the other side thereof to define a strip beginning at the first end of the tube and continuing substantially in a serpentine manner within areas of plurality of primary weakening line sections and continuing substantially helically between respective adjacent primary weakening line sections to the second end of the tube the strip comprising a free end starting from the second end of the tube and extending through the tube so as to project from the first end of the tube (figure 8 number 37, 31 and 36). Tsukazaki et al. discloses that the opposite ends of two respective adjacent primary weakening line sections are located at opposite lateral sides of a phantom line (figure 8 number 33). Tsukazaki et al. discloses two respective adjacent primary weakening line sections are curved in opposite directions (figure 6). Tsukazaki et al. discloses that the opposite ends of two respective adjacent primary weakening line sections are displaced in a substantially circumferential direction and are in alignment with respect to each other (figure 6). Tsukazaki et al. discloses that the secondary weakening lines extending from one primary weakening line section to an adjacent one comprises at least one winding around the tube (figure 8 number 31). Tsukazaki et al. discloses that each secondary weakening line extends substantially circumferentially of tube (figure 8 number 36). Tsukazaki et al. discloses that the arrangement of the plurality of primary weakening line sections extends alternately to opposite lateral sides of a phantom line (figure 8 number 33). Tsukazaki et al. discloses that the phantom line is a straight line and is substantially parallel to the longitudinal axis of the core (an imaginary line that can be placed anywhere in figure 8). Tsukazaki et al. discloses that the arrangement of the plurality of primary weakening line sections

Art Unit: 1772

extends symmetrically to the phantom line (figure 8 numbers Q1, Q2, Q3). Tsukazaki et al. discloses that the plurality of primary weakening line sections are zig-zag shaped (figure 6). Tsukazaki et al. discloses that for all of the secondary weakening lines, the distance in circumferential direction by which a termination point of the secondary weakening line is spaced from at least one primary weakening line is constant (figure 8 number 36). Tsukazaki et al. discloses that for all of the secondary weakening lines the distance in circumferential direction by which a termination point of a secondary weakening line is spaced from a primary weakening line sections is smaller than a width defined by two successive outermost locations of the arrangement of the plurality of primary weakening line sections arranged on opposite lateral sides of the phantom line (figure 8 number 36 and 33). Tsukazaki et al. discloses that the distance is substantially the width of the strip within its portions close to the termination points (figure 8 number 37). Tsukazaki et al. discloses that the termination points of the secondary weakening lines is provided with radially extending holes (figure 8 q2). Tsukazaki et al. discloses that the overall extension of the arrangement of the plurality of primary weakening line sections is inclined with respect to the longitudinal dimension of the tube (figure 8 number 33). Tsukazaki et al. discloses that the secondary weakening lines are comprised of perforations in the tube and has a reduced thickness in relation to the remaining parts of the tube (col. 3 line 45). Tsukazaki et al. discloses that wherein the secondary weakening lines extend from one primary weakening line section to an adjacent one comprises at least one winding along the tube (figure 8 number 36, 33, R1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12,13,15-28, 44,45, 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsukazaki et al. in view of Sadlo et al. (5925427).

Tsukazaki et al. discloses the removable core described above. Tsukazaki et al. fail to disclose that the primary weaken line is perforated and has a reduced thickness in relation to the remaining parts of the tube. Tsukazaki et al. fail to disclose two primary lines of localized weakening starting at the first end and terminating at the second end of the tube and spaced apart in circumferential dimension of the tube. Tsukazaki et al. fail to disclose at least two weakening lines extend alternately to opposite lateral sides of a straight phantom line. Tsukazaki et al. fail to disclose at least two weakening lines extend symmetrically to the respective phantom line. Tsukazaki et al. fail to disclose at least two weakening lines that have a periodical corrugated, zig-zag shaped triangular rectangular or trapezoidal wave form. Tsukazaki et al. fail to disclose that the tube has a substantially continuous wall having a substantially uniform thickness between the first and second opposite ends.

Sadlo et al. teaches that the primary weaken line is perforated (col. 4 line 35) and has a reduced thickness in relation to the remaining parts of the tube for the purpose to

Art Unit: 1772

control the force necessary to separate the core into a strip for removal (col. 4 lines 38-39). Sadlo et al. teaches two primary lines of localized weakening starting at the first end and terminating at the second end of the tube and spaced apart in circumferential dimension of the tube for the purpose of increasing the uniformity of the force necessary to separate the helical coils of the core when it is desired to remove the core from the sleeve (col. 2 lines 39-43). Sadlo et al. teaches that the tube has a substantially continuous wall having a substantially uniformed thickness between the first and second opposite ends (col. 2 lines 36-37) for the purpose of providing a more uniformed and predictable characteristics than previous constructions (col. 2 lines 19-20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Tsukazaki et al. with the tube that has a substantially continuous wall having a substantially uniformed thickness between the first and second opposite ends in order to provide a more uniformed and predictable characteristics than previous constructions (col. 2 lines 19-20).

Therefore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Tsukazaki et al. with the primary weaken line that is perforated and has a reduced thickness in relation to the remaining parts of the tube in order to control the force necessary to separate the core into a strip for removal (col. 4 lines 38-39) as taught by Sadlo et al.

Also, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Tsukazaki et al. with two primary lines of localized weakening starting at the first end and terminating at the second end of the

Art Unit: 1772

tube and spaced apart in circumferential dimension of the tube for the purpose of increasing the uniformity of the force necessary to separate the helical coils of the core when it is desired to remove the core from the sleeve (col. 2 lines 39-43) as taught by Sadlo et al.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Tsukazaki et al. with two weakening lines extend alternately to opposite lateral sides of a straight phantom line or two weakening lines extend symmetrically to the respective phantom line, since the "phantom line" is an imaginary line, one can place it any respective area where one seems fit such as in-between two weakening lines wherein the two weakening lines can be on opposite lateral sides of a straight phantom line and/or extend symmetrically to the respective phantom line.

As to the two weakening lines that have a periodical corrugated, zig-zag shaped triangular rectangular or trapezoidal wave form, Tsukazaki et al. teaches one weakening line can be in the shape of a zig-zag (figure 6), it would have been obvious to one having ordinary skill in the art to provide two weakening lines with zig-zag shapes since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper Co.v Bemis Co., 193 USPQ 8.

Response to Arguments

5. Applicant's arguments filed 7/01/03 have been fully considered but they are not persuasive.

In response to applicant's argument that Tsukazaki et al. does not meet the description of either a extruded tube or extruded cylinder, the new limitation to the tube wherein the tube is now amended to be an extruded tube is a process by product limitation. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

Furthermore, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitation extruded tube is a method of production and therefore does not determine the patentability of the product itself.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

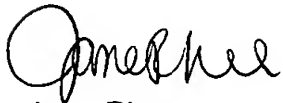
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane J Rhee whose telephone number is 703-605-4959. The examiner can normally be reached on M-F.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Art Unit: 1772

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jane Rhee
September 9, 2003


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

9/22/03